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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,845	03/12/2001	Sam J. DiRaimondo	CM01891G	1286
22917	7590	09/17/2004	EXAMINER	
MOTOROLA, INC. 1303 EAST ALGONQUIN ROAD IL01/3RD SCHAUMBURG, IL 60196			PHAN, RAYMOND NGAN	
			ART UNIT	PAPER NUMBER
			2111	

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 09/803,845	<b>Applicant(s)</b> DIRAIMONDO ET AL.	
	<b>Examiner</b> Raymond Phan	<b>Art Unit</b> 2111	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-20 is/are allowed.
- 6) ☒ Claim(s) 1,2,8 and 9 is/are rejected.
- 7) ☒ Claim(s) 3-7,10,11,21 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **Part III DETAILED ACTION**

#### ***Notice to Applicant(s)***

1. This action is responsive to the following communications: amendment filed on June 28, 2004
2. This application has been examined. Claims 1-22 are pending.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2 are rejected under 35 U.S.C. § 102(b) as being anticipated by Alanara et al. (EPNo 448369A2).

In regard to claim 1, Alanara et al. disclose a method of regulating usage in a smart card system comprising at a card acceptance location (see col. 1, lines 1-30); detecting the presence of the card (see col. 4, lines 6-41); determining an ID code from the smart card (see col. 4, lines 6-41); checking the ID code against a list stored locally at the card acceptance location, wherein the list is received from a second device (see col. 3, lines 16-35); and if the ID code of the smart card is listed on the list, performing an action on the smart card (see col. 4, lines 6-41).

In regard to claim 2, Alanara et al. disclose wherein the action is selected from a group of consisting of disabling the smart card, enabling the smart card (see col. 4, lines 6-41).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Alanara et al. in view of Freeman et al. (US No. 6,068,183).

In regard to claim 8, Alanara et al. disclose the claimed subject matter as discussed above rejection except the teaching of wherein the action performed is modifying parameter to the smart card which indicates discounts, rebate, purchase. However Freeman et al. disclose modifying parameter to the smart card which indicates discounts, rebate, purchase (see col. 3, line 46 through col. 4, line 16). Therefore, it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to have combined the teachings of Freeman et al. within the system of Alanara et al. because it would speed up the business transactions and reduce paperwork.

In regard to claim 9, Freeman et al. disclose wherein the parameter is based on at least loyalty program, type of concession (see col. 3, line 46 through col. 4, line 16). Therefore, it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to have combined the teachings of

Freeman et al. within the system of Alanara et al. because it would speed up the business transactions and reduce paperwork.

***Allowable Subject Matter***

7. Claims 12-20 are allowable over the prior of records.
8. Claims 3-7, 10-11, 21-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Amendment***

9. Applicant's arguments, see pages 7-9, filed on June 28, 2004, with respect to the rejection(s) of claim(s) 1-4, 8-9 under 35 USC 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Alarana et al.

***Conclusion***

10. Claims 1-2, 8-9 are rejected. Claims 3-7, 10-11 and 21-22 are objected. Claims 12-20 are allowed.
11. The prior arts made of record and not relied upon are considered pertinent to applicant's disclosure.

**Hamann et al. (US No. 6,516,357)** disclose a system for accessing virtual smart cards for smart card application and data carrier.

**Leonardi (US No. 6,556,680)** discloses a method for authorization check.

**Guthery (US No. 6,763,463)** discloses an integrated circuit card with data modifying capabilities and related methods.

**Drupsteen et al. (US No. 5,856,659)** disclose a method of securely modifying data on a smart card.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Raymond Phan, whose telephone number is (703) 306-2756. The examiner can normally be reached on Monday-Friday from 6:30AM- 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Primary, Paul Myers can be reached on (703) 305-9656 or via e-mail addressed to paul.myers@uspto.gov. The fax phone number for this Group is (703) 746-7239.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [raymond.phan@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.



PAUL R. MYERS  
PRIMARY EXAMINER



**Raymond Phan**  
9/13/04